

REMARKS

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicants' Prior Art FIG. 5 in view of Yamane (JP 09-147615). Applicants respectfully traverse the rejection and request reconsideration because the rejections fail to set forth a *prima facie* case of obviousness.

Independent claim 4 recites, in part, an under light type back light unit wherein "light emitted from one of the plurality of linear light sources is shielded by the light shielding plate and transmitted through only the light diffusion plate to irradiate a second portion of the liquid crystal panel from the rear side thereof with a second luminance higher than the first luminance." At least this feature of independent claim 4 is neither taught nor suggested by Applicants' Prior Art FIG. 5 and Yamane, whether taken singly or combined.

The Office Action admits that Applicants' Prior Art FIG. 5 does not disclose a light source shielded by a light shield. Thus, the Office Action relies upon Yamane for teaching a light shielding plate 4 "which is capable of irradiating a second portion of a panel from a rear [side thereof] with a luminance higher than a first luminance." As a result, the Office Action alleges that it would have been "obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Yamane with the APA, since that would raise brightness at upper surface of a plate as taught by Yamane." However, Applicants respectfully assert that the Office Action's alleged motivation to modify Applicants' Prior Art FIG. 5 (i.e., to add from Yamane slots 4 that are capable of providing different luminances) is not taught or suggested anywhere in Yamane or Applicants' Prior Art FIG. 5. There is no motivation because the slots 4 of Yamane do not provide for different luminances. Instead, the slots 4 of Yamane

provide for an optimal luminance distribution (Applicants' provide herewith an English-language translation of Yamane obtained from the JPO website). The optimal luminance distribution of Yamane might be argued to be motivation to have a plurality of slots of a light guide plate, but certainly would not be motivation to provide light having different luminances.

Accordingly, Applicants respectfully note that MPEP 2143.01 instructs that "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention, where there is some teaching, suggestion or motivation to do so found in either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." Moreover, MPEP 2143 instructs that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless that prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)." Thus, Applicants assert that the Office Action has not provided any motivation for one of ordinary skill in the art to modify the teachings of Applicants' Prior Art FIG. 5 with the teachings of Yamane to achieve the invention of claim 4.

Since the Office Action fails to meet the requirements for establishing a *prima facie* case of obviousness as to independent claim 4, claim 4 is not obvious. Thus, Applicants respectfully request that the rejection of claim 4 under 35 U.S.C. § 103(a) be withdrawn.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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